

REMARKS

Summary of Office Action

Claims 13-21 were pending in this application.

Claims 13-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Beaudry WIPO International Publication No. WO 97/42918 ("Beaudry").

Claim 14 was objected to due to the recitation of two ends being "the same end."

The drawings were objected to under 37 CFR § 1.83(a) for failing to show some of the features recited in claims 16, 18 and 20.

Summary of Telephonic Interview

Examiner Smith, applicant and the undersigned agent of record (hereinafter "applicant's representative") conducted a telephonic interview on April 10, 2008. Applicant and applicant's representative wishes to thank the Examiner for the courtesies extended during the interview.

The Examiner and applicant's representative discussed applicant's independent claim 13 and Beaudry. Applicant's representative pointed out that Beaudry failed to show all of applicant's claimed features. In particular, Beaudry did not show or suggest applicant's claimed feature of "acting to separate said swollen tissue from non-swollen tissue." Applicant's claim 13.

The Examiner acknowledged that Beaudry did not suggest that feature of applicant's claims, but argued that the feature was a functional feature produced by an apparatus "identical or substantially identical in

structure" to applicant's claimed invention.

MPEP § 2112.01 (citing In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977)). This shifted the burden to applicant to prove that Beaudry and applicant's claimed invention are not the same. See id. Applicant's representative argued that Beaudry and applicant's claimed invention (without any amendment) are not the same, but the Examiner was not convinced.

In order to expedite allowance of this case,* applicant's representative suggested an amendment to independent claim 13. In particular, applicant's representative suggested amending claim 13 to recite "said strip of material is crescent shaped." Support in the originally filed specification for this amendment can be found at, for example, page 13, lines 26-29.

Applicant then explained the advantages of the strip of material being crescent shaped when it is used to separate swollen tissue from non-swollen tissue, especially when that tissue is in or near the buttocks, as recited in new claim 27. (Support in the originally filed specification for new claim 27 can be found at, for example, page 14, lines 28-30.) Among other things, the crescent shape of the material allows the person using the claimed invention to move more freely and without an uncomfortable pulling of the skin. Applicant's

* Applicant hereby submits for the record that applicant's previously pending, unamended claim 13 is different and, therefore, not anticipated by Beaudry. If necessary, applicant reserves the right to submit further arguments as to why the previously pending, unamended claim 13 is patentable.

representative also pointed out that Beaudry does not show or suggest a crescent shape material having the features recited in applicant's claims.

The Examiner indicated that such an amendment would overcome Beaudry. However, the Examiner said he would like to conduct another prior art search before concluding that the claims were patentable. Accordingly, applicant formally submits herein the amendments presented during the Interview.

Applicant's Reply to the 35 U.S.C. § 102(b) rejections

Claims 13-21 were pending in this application. Claims 13-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Beaudry. The rejections are respectfully traversed.

Applicant has canceled claims 16-18 and 20 without prejudice.

In addition to the reasons discussed above, "the prior art cannot anticipate the claim if there is any structural difference." MPEP § 2114. See also In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require the three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.) Applicant's independent claim 13 would be allowable at

least because of the strip's crescent shape, which is a structural difference from anything suggested by Beaudry.

Claims 14, 15, 19, 21 and 27 depend on allowable claim 13 and, therefore, are also allowable. Accordingly, applicant respectfully requests that the rejection of claims 13-15, 19 and 21 under 35 U.S.C. § 102(b) be withdrawn.

Applicant has added new method claims 28-32. Independent method claim 28 recites the same patentable features of independent claim 13. That is, among other things, claim 28 recites "applying a crescent shaped strip of material . . . causing swollen tissue of said person's body to be separated from non-swollen tissue of said person's body." Applicant's new claim 28. For at least this reason, independent claim 28 is allowable.

New claims 29-32 depend on allowable claim 28 and, therefore, are also allowable.

Applicant's Reply to the claim 14 objection

Claim 14 was objected to due to the recitation of two ends being "the same end." Applicant has amended claim 14, which no longer recites "the same end." Accordingly, the objection to claim 14 should be withdrawn.

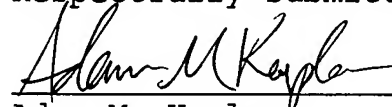
Applicant's Reply to the drawings objection

The drawings were objected to under 37 CFR § 1.83(a) for failing to show some of the features recited in claims 16, 18 and 20. Claims 16, 18 and 20 have been canceled. The objections to the drawings are now moot and should be withdrawn.

Conclusion

For at least the reasons set forth above, applicant respectfully submits that this application is in condition for allowance. Reconsideration in light of the foregoing remarks and a favorable action are respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Adam M. Kaplan", is written over a horizontal line.

Adam M. Kaplan

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